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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,251	06/22/2006	Jacmoon Lee	VT7-008US	3765
959 7590 04/03/2008 LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127				
EXAMINER ZEWARI, SAYED T				
ART UNIT 2617		PAPER NUMBER		
MAIL DATE 04/03/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,251

**Applicant(s)**

LEE ET AL.

**Examiner**

SAYED T. ZEWARI

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The Art Unit Location Of Your Application In The USPTO Has Changed. To Aid In Correlating Any Papers For This Application, All Further Correspondence Regarding This Application Should Be Directed To Art Unit 2617.

## DETAILED ACTION

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 11, 13-14, 16-17, and 20-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 5-11 of copending Application No. 10541252 in view of Kolev et al. (US 6, 125,283).

This is a provisional obviousness-type double patenting rejection.

Claims 1 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly details generating a connection deny message whereas the previous claims details generating overhead message. However, Kolev et al. (US 6125283) discloses generating a deny message (See Kolev's figure 5, col.8 lines 5-21 where a deny message is generated before a terminal is switched to another mode). Therefore, it would have been obvious to one skilled in the art to combine the invention of the application 10541252 with the invention of Kolev thereby providing a multimode system that generates a deny message and switch to another system when a malfunction occurs.

Claims 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 11 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly details switching a call connection when a malfunction occurs whereas the previous claims details periodically switching from one mode to another. However, Kolev et al. (US 6125283) discloses switch a connection when a malfunction occurs (See Kolev's figure 5, col.8 lines 5-21 where a malfunction occurs and a deny message is generated before a terminal is switched to another mode). Therefore, it would have been obvious to one skilled in the art to combine the invention of the application 10541252 with the invention

of Kolev thereby providing a multimode system that generates a deny message and switch to another system when a malfunction occurs.

Claims 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly adds the phrase *"through which data are transmitted from 1xEV-Do system to the hybrid access terminal"* indicating that data are transmitted on forward link. This addition to the claim does not change the scope of the claim with regard to the conflicting claim. This is

merely a restatement from claim 4 which states *"...a forward link transmitting data from the 1xEV-DO system to the hybrid access terminal..."*

Claims 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Application No. 10541252. The instant claims are broader in scope with the conflicting claims and thus encompass the subject matter previously patented. The only difference between the applicant's claim and the conflicting claim is that the applicant uses active voice *"...terminal switches..."* and the conflicting claim uses passive voice *"...terminal is switched..."*

Claims 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Application No. 10541252. The

instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 24 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 25 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

6. Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10541252 in view of Kolev et al. (US 6, 125,283) and further in view of Lee et al. (US 6,842,619).

This is a provisional obviousness-type double patenting rejection.

Claims 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly mentions transmitting the high-rate data "...in one sector." This addition to the claim does not change the scope of the claim. The conflicting claim discloses a 1xEV-DO system for the sole purpose of high data rate communication. The high data rate communication inherently involves use of maximum power during transmission. See Lee et al. US 6,842,619 specifically col.2 lines 14-27 where a Data Rate Controller is disclosed for controlling the data rate for a sector of a cell.



7. Claims 9, 10, 18, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 and 10 of copending Application No. 10541252 in view of Kolev et al. (US 6, 125,283) and further in view of Ling (US 5,412,686).

This is a provisional obviousness-type double patenting rejection.

Claims 9, 10, 18, and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 and 10 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claim explicitly mentions the word coherent detection. The conflicting claim 10 discloses a pilot channel and the conflicting claim 9 discloses tracking frequency of system. Ling discloses the limitation of coherent detection (See Ling's col.3 lines 19-35, US 5,412,686). Therefore, It would have been obvious to one skilled in the art to combine the invention of the above application with Ling thereby providing a system that discloses pilot channel and use of coherent detection.

8. Claims 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

10541252 in view of Kolev et al. (US 6, 125,283) and further in view of Thauvin et al. (US 6,360,109).

This is a provisional obviousness-type double patenting rejection.

Claims 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Application No. 10541252. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly details receiving a connection acknowledgement message. However, Thauvin et al. (US 6,360,109) discloses the use of a connection acknowledgement. Therefore, it would have been obvious to one skilled in the art to combine the invention of the above application with the invention of Thauvin, thereby providing a system where a connection acknowledgement message is used (See Thauvin's col.6 lines 60-64).

9. Claims 15 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10541252 in view of Kolev et al. (US 6, 125,283) and further in view of Thauvin et al. (US 6,360,109) and still further in view of Abrol et al. (US 7,068, 669).

This is a provisional obviousness-type double patenting rejection.

Claims 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Application No. 10541252. The

instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claim explicitly details the use of UATI (Unicast Access Terminal Identifier). However, Abrol et al. (US 7,068,669) discloses the use of UATI. Therefore, it would have been obvious to one skilled in the art to combine the invention of the above application with the invention of Abrol, thereby providing a system where UATI is used as a session identifier (See Abrol's col.14 claim 19).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sayed T. Zewari whose telephone number is 571-272-6851. The examiner can normally be reached on 8:30-4:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sayed T Zewari/

Examiner, Art Unit 2617

March 25, 2008

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617